

**REMARKS**

Claims 1-8, 22-29, and 31-48 are pending in the current application. Claims 9 and 11-21 are cancelled herein. Claims 1, 22, and 26 are amended herein to recite that the layer of oil absorbing material, when saturated with oil, forms an oil-and-water-impermeable barrier. Claims 1, 22, and 26 are also amended herein to no longer recite the feature of the water permeable membrane or fabric. Claims 6 and 24 are amended herein to recite an oil and water permeable fabric. New claims 34-48 have been added. Support for the claim amendments and for the new claims can be found, for example, on paragraphs [0021-0023] and [0030 - 0032] of the specification and in Fig. 1. No new matter has been added.

The Examiner has rejected claims 1-4, 22-24, 26, 31 and 32 under 35 USC 103(a) as being unpatentable (obvious) over Bamer. Specifically, the Examiner contends that Bamer discloses a container having two layers of oil sorbing materials separated by permeable layers as claimed. The Examiner acknowledges that Bamer does not disclose the specific order of an adsorbent over an absorbent. However, the Examiner submits that Bamer discloses the use of both adsorbents, such as diatomaceous earth, vermiculite, nylon, polypropylene and oyster shells as well as absorbents, such as activated carbon, perlite, fibrous cellulose and cotton. The Examiner concludes that one of ordinary skill in the art would obviously arrange the specific materials in the most advantageous order and that therefore use of an adsorbent over an absorbent would have been an obvious configuration absent a declaration showing unexpected results.

As acknowledged by the Examiner, Bamer fails to disclose an adsorbent layer over an absorbent layer. Although the Examiner states that it would be obvious to arrange an adsorbent layer on top of an absorbent layer, no evidence has been provided by the Examiner that in Bamer the most advantageous order is the adsorbent material over the absorbent material. The Supreme Court has explained the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new

invention does." See *KSR<sup>1</sup> International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007). No such reason has been provided by the Examiner and therefore *prima facie* obviousness is absent.

Moreover, the disclosure of Bamer teaches arranging the adsorbent material over the adsorbent material, in contrast to the claimed invention. Bamer is directed to a filter for a storm drain and discloses in column 4, lines 48-58 that the bags are arranged in an order "such that the water first passes through filter media formulated to remove the poisoning pollutant before the water is passed through the other filter media thereby ensuring removal of all pollutants. In many situations, an effective selection is fibrous cellulose particulate absorbent in bag 42 which absorbs the majority of the hydrocarbon and similar organics; and specially textured activated carbon in the lower bag 40 to remove organically bound heavy metals, break-through hydrocarbons, and VOCs (volatile organic compounds)." Thus, Bamer teaches that substances such as the majority of the hydrocarbons and similar organics will poison the adsorbent material such as activated carbon<sup>1</sup> and that, therefore, the adsorbent material is on the bottom so that it can adequately adsorb compounds such as heavy metals without being "poisoned" by the majority of the hydrocarbons and similar organics. Thus, Bamer teaches away from placing the adsorbent material on top of the absorbent material because the adsorbent material would then be "poisoned" by the hydrocarbons. The Federal Circuit has stated that, as a general rule, references that teach away cannot serve to create a *prima facie* case of obviousness. See *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001). Accordingly, *prima facie* obviousness is absent and claims 1, 22, and 26 are further patentable for this reason.

Additionally, Applicant has amended claims 1, 22 and 26 to specify that the layer of oil absorbing material, when saturated with oil, forms an oil and water impermeable barrier. A surprising improvement of the present invention over the prior art is that the oil absorbing material forms a barrier when it is saturated with oil. When an oil spill or leak occurs, oil is

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<sup>1</sup> Although the Examiner characterizes activated carbon as an absorbent rather than as an adsorbent, one of ordinary skill in the art would characterize activated carbon as an adsorbent. See attached excerpt from Merriam-Webster OnLine.

temporarily trapped in the oil adsorbing material. The oil adsorbing layer captures the oil released until it becomes saturated. Additional amounts of oil released into the containment area travel through the saturated oil adsorbing material, reaching the oil absorbing material. Upon contact with the oil, the oil absorbing material absorbs the oil, forming an impermeable membrane. This membrane seals the containment system and additional oil released into the containment system will be held by the impermeable layer formed between the absorbing material and the oil. Thus, when the oil absorbing material absorbs oil, it expands into an impermeable membrane. This impermeable barrier is neither taught nor suggested in Bamer or indeed any other cited prior art. Accordingly, claims 1, 22, and 26 are patentable for this reason as well. Claims 2-4, 23-24, 31, and 32 are patentable at least for the reason that they depend from a patentable base claim.

The Examiner has rejected claims 1-8 and 22-31 as being anticipated by Ross et al. ("Ross"). The Examiner contends that Ross discloses a multi-layer filter having a fire retardant material (gravel) over an adsorbent (peat) and an absorbent (wood ash) and an aggregate (gravel), each of which is separated by a permeable geotextile membrane. Applicant submits that the amendments to claims 1, 22, and 26, outlined above, render the amended claims novel over Ross et al. Claims 2-8, 23-25 and 27-31 are patentable at least for the reason that they depend from a patentable base claim.

The Examiner has rejected claim 33 under 35 USC 103(a) as being unpatentable (obvious) over Ross in view of Gannon.


The Examiner contends that claim 33 differs from Ross in the positioning of the containment basin beneath and around an oil containing vessel. The Examiner submits that it would have been obvious to one skilled in the art to adapt the separator of Ross for such a purpose in view of the teaching of similar separators being so used in the Gannon patent. Applicant respectfully submits that the amendments to claim 26 described above overcome this

rejection. Specifically, claim 33 is patentable at least for the reason that it depends from claim 26.

Additionally, claims 34-48 distinguish over the cited art. For example, the cited art fails to disclose or suggest the oil absorbing material comprising an oil absorbing copolymer or a granular polymer with oil absorbing properties. Furthermore, Bamer fails to disclose or suggest a water permeable membrane or fabric between the layer of oil adsorbing material and layer of oil absorbing material with the water permeable membrane or fabric being in contact with the layer of oil adsorbing material and the layer of oil absorbing material. Also, Ross fails to disclose or suggest a containment basin comprising concrete. Moreover, the cited art fails to disclose or suggest a liner being arranged in the containment basin, the liner being impermeable to water and oil and extending partially between the layer of oil adsorbing material and the layer of oil absorbing material.

In conclusion, taking into consideration the above remarks and the amendments, it is submitted that all of the claims are in condition for allowance, and reconsideration and a Notice of Allowance are respectfully solicited.

Respectfully submitted,  
**Luciano A. Gonzales, et al.**

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(Date)

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WWS/RUS/acw

Enc. Excerpt from Merriam-Webster OnLine

**activated carbon**

One entry found.

Main Entry: **activated carbon**Function: *noun*

Date: 1921

: a highly adsorbent powdered or granular carbon made usually by carbonization and chemical activation and used chiefly for purifying by adsorption—called also *activated charcoal*

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